

### Remarks

Applicants request reconsideration of the above-referenced patent application.

#### **I. Prior status of claims**

The June 15, 2004 Restriction Requirement and the September 15, 2004 Amendment A failed to take into account the fact that Applicants canceled claims 10-14 at the time they filed this patent application. *See Applicants' January 12, 2004 Utility Patent Application Transmittal (page 1).* Only claims 1-9 and 15-17 were pending at the time of the November 19, 2004 Office action.

#### **II. Claim amendments**

Applicants have added new claims 18-24. Thus, claims 1-9 and 15-24 are pending. Applicants have amended claims 1-9 and 15-17. All the claims, including the amendments, are shown in the previous section. Applicants submit that the amendments and new claims do not introduce any new matter. Specifically:

Claims 1-5 and 7-9 have been amended to conform the claims to Group II of the June 15, 2004 restriction requirement.

In claim 1, the Y definition has been amended to remove alkylarylalkynyloxy, alkylarylalkenyloxy, alkylarylalkynylthio, and alkylarylalkenylthio; the Ar definition has been amended to remove mercapto from the list of optional substituents; the R<sup>5</sup> definition has been amended to remove carboxyl, aminocarbonyl, alkylaminocarbonyl, alkoxycarbonyl, acyl, and cyano; and the R<sup>7</sup> definition has been amended to remove alkoxy. Claims 2-5 have been amended to be consistent with these amendments.

In claim 1, the Y definition has been amended add aralkylthioalkyl, aralkoxyalkyl, and alkoxyaralkoxyalkyl. These substituents were present in claim 1 as originally filed, but inadvertently omitted in the listing of claims in the September 15, 2004 Amendment A. The amendment simply corrects this typographical error.

In claim 1, the proviso has been removed. This proviso is directed to compounds wherein A is oxazolyl. Given that such a substituent does not fall within the restricted scope of A, the proviso is inapplicable.

In claims 1-4, the September 15, 2004 Amendment A inadvertently replaced "R<sup>5</sup>" with "OR<sup>5</sup>" in the structure in the list of optional substituents in the Ar definition. Applicants have amended the claims to fix this typographical error.

In claim 2, the A definition has been amended to replace "pyrrolyl" with "pyrazolyl" in accordance with Applicants' election of Group II. This amendment is supported by claim 2, as originally filed, which included pyrazolyl in the list of A substituents.

In claim 7, the September 15, 2004 Amendment A inadvertently omitted the original definition for R<sup>2</sup>, and instead defined R<sup>2</sup> using the R<sup>9</sup> definition. Claim 7 has been amended to correct this error by defining R<sup>2</sup> and R<sup>9</sup> consistent with claim 7 as originally filed.

In claim 7, the September 15, 2004 Amendment A inadvertently replaced "R<sup>10</sup>" with "R<sup>5</sup>" in Formula II. Formula II in claim 7 has been amended to fix this error so that Formula II corresponds to Formula II in claim 7 as originally filed.

In claim 7, the Y definition has been amended to remove lower alkylarylalkynyloxy, lower dialkylaminoalkyloxy, lower dialkylaminocarbonylalkyloxy, and lower alkoxycarbonylalkyl. Claims 8 and 9 have been amended to be consistent with this amendment.

Claims 15-17 have been amended to depend from claim 20 rather than canceled claim 14.

New claims 18 and 19 are supported by, for example, original claim 10.

New claims 20 and 21 are supported by, for example, original claim 11.

New claims 22-24 are supported by, for example, original claims 15-17, respectively.

Other amendments rephrase the claims, remove redundancies or unnecessary terms, or correct grammatical or obvious errors. Applicants submit that such amendments are permissible under MPEP §2163.07.

Applicants reserve the right to pursue any canceled subject matter and/or any other subject matter disclosed in this application in one or more later-filed divisional and/or continuation applications.

### **III. Response to characterization of Group II in paragraphs 3-4 of Office action**

The Office action indicates that Group II excludes compounds wherein Ar is a substituent substituted with heteroaryl or heterocycle. Applicants respectfully submit that Group II, as set forth in the June 15, 2004 restriction requirement, only excludes compounds wherein Ar is a

substituent substituted with a heteroaryl. Thus, Group II includes compounds wherein Ar is a substituent substituted with a *non-heteroaryl* heterocycle, and particularly tetrahydropyranyl.

**IV. Response to rejection of claims 2-9 under 35 U.S.C. §112 (second paragraph)**

Claims 2-9 have been rejected under 35 U.S.C. §112 (second paragraph) as failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. Applicants request withdrawal of this rejection.

Claim 2 has been rejected for defining A as an optionally substituted pyrrolyl. The recitation of pyrrolyl in claim 2 stems from an inadvertent error in the September 15, 2004 Amendment A. As noted above, claim 2 has been amended by this amendment to replace pyrrolyl with pyrazolyl in accordance with Applicants' election of Group II. Applicants believe this amendment moots this rejection.

Claim 7 has been rejected as failing to define the  $R^9$  variable in Formula II. As noted above, the September 15, 2004 Amendment A inadvertently omitted the original definition for  $R^2$ , and instead defined  $R^2$  using the  $R^9$  definition. Claim 7 has been amended to correct this error by defining  $R^2$  and  $R^9$  consistent with claim 7 as originally filed. Applicants believe this amendment moots this rejection.

Claim 7 has been rejected as defining a variable  $R^{10}$  that is not present in Formula II and not defining the  $R^5$  variable in Formula II. As noted above, the September 15, 2004 Amendment A inadvertently replaced " $R^{10}$ " with " $R^5$ " in Formula II. Formula II has been amended to fix this error. Applicants believe this amendment moots the rejection.

Claims 3-6 depend directly or indirectly from claim 2. Thus, Applicants submit that the rejection as to claims 3-6 has been mooted for the same reason as discussed above with respect to claim 2.

Claims 8 and 9 depend directly or indirectly from claim 7. Thus, Applicants submit that the rejection as to claims 8 and 9 has been mooted for the same reason as discussed above with respect to claim 7.

**V. Response to rejection of claims 1-6 and 10 under 35 U.S.C. §102(a)**

Claims 1-6 and 10 have been rejected under 35 U.S.C. §102(a) as being anticipated by Numata et al., WO 96/14302. Applicants request withdrawal of this rejection. Claim 10 has been canceled, thus mooted this rejection as to that claim. As to the remaining claims, Applicants submit that WO 96/14302 cannot be cited against Applicants' application under 35 U.S.C. §102(a). Specifically, Applicants' application is a continuation of U.S. Appl. No. 10/004,960, which, in turn, is a continuation of U.S. Appl. No. 09/549,830, which, in turn, is a continuation of U.S. Appl. No. 08/952,661, which, in turn, is a national-phase application of Int'l Appl. No. PCT/US96/08183, which, in turn, claims priority to U.S. Appl. No. 08/460,324 (issued as U.S. Pat. No. 5,643,933). Applicants believe the amended claims in the instant application are fully supported by U.S. Appl. No. 08/460,324. The filing date for U.S. Appl. No. 08/460,324 is June 2, 1995. This priority date precedes the May 17, 1996 publication date of WO 96/14302. Accordingly, Applicants submit that WO 96/14302 cannot be cited as prior art under 35 U.S.C. §102(a). *See, e.g.*, MPEP §706.02(a)(II)(C) ("For 35 U.S.C. 102(a) to apply, the reference must have a publication date earlier in time than the effective filing date of the application . . .").

**VI. Response to objection to claims 1-10 as reciting non-elected subject matter**

An objection has been raised to claims 1-10 for reciting non-elected subject matter. Applicants request withdrawal of this objection. Claim 10 has been canceled, thus mooted this objection as to that claim. As to the remaining claims, Applicants submit that the claim amendments have mooted this objection. Specifically:

- A. The amended claims define A as being optionally substituted pyrazolyl.
- B. The Y definitions in the amended claims do not include any heterocyclic moiety.
- C. The R<sup>1</sup> definitions in the amended claims do not include any heterocyclic moiety.
- D. As noted above, Group II, as set forth in the June 15, 2004 restriction requirement, only excludes compounds wherein the variable Ar is heteroaryl, or a substituent substituted with heteroaryl. Thus, Group II includes compounds wherein Ar is a substituent substituted with a *non-heteroaryl* heterocycle. Accordingly, the definitions for Ar in the amended claims do not recite any

heteroaryl moieties. The definitions, however, do encompass optionally substituted tetrahydropyranyl as an optional substituent.

**VII. Response to objection to claim 10 as having an improper dependency**

An objection has been raised to claim 10 as being in improper form because it does not refer to other claims in an alternative manner. Applicants request withdrawal of this objection because claim 10 has been canceled, thus mooted this objection.

**VIII. Request for rejoinder of method-of-treatment claims**

Although examination is currently restricted to compound and composition claims, Applicants request that the corresponding method-of-treatment claims (*i.e.*, claims 15-17 and 20-24) be rejoined into the application to the extent that such claims have the same limitations as any allowed compound claims. Under such a circumstance, this rejoinder is required:

Process claims which depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance.

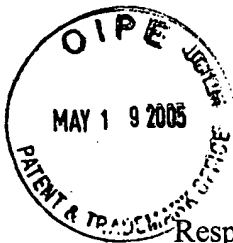
MPEP §821.04 (emphasis added).

\* \* \* \* \*

Applicants hereby request a 3-month extension to respond to the November 19, 2004 Office action, and have enclosed a check to cover the fee for the extension. Applicants believe that they do not owe any additional fee in connection with this filing. If, however, Applicants do owe any such fee(s), the Commissioner is hereby authorized to charge the fee(s) to Deposit Account No. **08-0750**. In addition, if there is ever any other fee deficiency or overpayment under 37 C.F.R. §1.16 or 1.17 in connection with this patent application, the Commissioner is hereby authorized to charge such deficiency or overpayment to Deposit Account No. **08-0750**.

Applicants submit that the pending claims are in condition for allowance, and request that this application be allowed. The Examiner is requested to call the Undersigned if any issues arise that can be addressed over the phone to expedite examination of this application.

U.S. Appl. 10/757,606  
Amendment B  
May 19, 2005



Respectfully submitted,

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**CERTIFICATE OF MAILING UNDER 37 CFR § 1.8**

I certify that this correspondence is being deposited with the U.S. Postal Service on **May 19, 2005** with sufficient postage as first class mail (including Express Mail per MPEP §512), and addressed to **Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450**.

DMG/PML